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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,772	09/19/2005	Derek Michael Auret	10338-22US (12553300ALC)	7881
570 7590 05/12/2008 PANITCH SCHWARZE BELISARIO & NADEL LLP ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103			EXAMINER KENNEDY, JOSHUA T	
			ART UNIT 3679	PAPER NUMBER
			MAIL DATE 05/12/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/549,772	<b>Applicant(s)</b> AURET, DEREK MICHAEL	
	<b>Examiner</b> JOSHUA T. KENNEDY	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,6,7,9-13 and 24-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,6,7,9-13 and 24-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/19/2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/17/2008 has been entered.

Claims 1, 3, 6, 7, 9-13 and 24-32 have been examined

Claims 2, 4, 5, 8 and 14-23 have been cancelled.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 66 and 67. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 6, 7, 9, 12, 13, 25-28 and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Lichti (US Patent 5,382,001).

As to Claim 1. Lichti discloses a panel for a fence comprising:

at least one hollow rail (69); and

a plurality of pickets (68) supported by the rail, each picket passing through a first aperture (86) and a second aperture (Examiner considers the aperture to be formed at the bottom face of the interior wall portion 87, i.e., the open entrance to groove 88; alternatively, note holes 115) in the rail and having a longitudinal axis (Fig 8), the first aperture being spaced from the second aperture along the longitudinal axis, a portion of each picket located inside of the rail between the first and second apertures being compressed partially radially inwardly (91, Col 6, Lines 20-33) within the rail in first and second converging directions generally perpendicular to the longitudinal axis thereby expanding the portion of each picket located inside of the rail partially radially outwardly

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(Fig 9) within the rail in first and second diverging directions, the first and second diverging directions being generally perpendicular to the first and second converging directions to thereby prevent further passage of each picket through the first and second apertures.

As to Claim 3. Lichti discloses the portion of each picket that has been deformed within the rail has a partly flattened shape (91) that no longer through the first and second apertures in the rail.

As to Claim 6. Lichti discloses the first aperture being on a first side of the rail and the second aperture is in an internal wall (87) within the rail such that each picket passes through the first side and the internal wall of the rail and ends proximate a second side of the rail and the internal wall is positioned between the first and second sides of the rail (Fig 8).

As to Claim 25. Lichti discloses a pair of rails which support the pickets (69,66).

As to Claim 30. It is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited. Accordingly, it is of little consequence how the flattened portion of the rail was formed when the flattened portion of the picket inside of the rail is present. See MPEP § 2113.

As to Claim 31. Lichti discloses wherein the rail is a tubular structure that has a unitary and continuous outer wall that extends around the periphery of the hollow rail (Fig 6).

As to Claim 32. Lichti discloses wherein the first and second diverging directions are perpendicular to the longitudinal axis of one of the plurality of pickets (Fig 9).

As to Claim 7. Lichti discloses a panel for a fence comprising:

- at least one hollow rail (109),

- a plurality of pickets (68) supported by the rail, the rail having an external wall with entry apertures (114) extending through the external wall for receiving the pickets; and

- an internal wall (113) spaced internally from the external wall and having holding apertures (115) for holding end portions of the pickets,

- wherein each picket enters the rail through a respective entry aperture and has-  
an the end portion of each picket passes through a corresponding holding aperture such that a portion of the picket is held between the respective entry aperture and the corresponding holding aperture (Fig 13).

As to Claim 9. Lichti discloses the holding apertures are aligned with the entry apertures so that the pickets are perpendicular to the rail.

As to Claim 12. Lichti discloses the holding apertures are formed by a plurality of flanges (Examiner considers the flanges to be the portions of the internal wall 113 which, in cross-section, extend between the portions of the pickets 116 and 117) which receive end portions of respective pickets.

As to Claim 13. Lichti discloses the pickets are fastened to the rail by a deformed portion of each picket within the rail (Fig 9).

As to Claim 26. Lichti discloses a panel for a fence comprising:

at least one tubular hollow rail (69) having a unitary and continuous outer wall extending around the periphery of the hollow rail (Fig 8); and

a plurality of pickets (68) on an imaginary plane supported by the outer wall of the rail, the pickets entering the rail by passage through respective entry apertures (86) in the outer wall of the rail, a portion of each picket located inside of the rail being compressed partially radially inwardly (91) within the rail in first and second converging directions generally perpendicular to the imaginary plane (Fig 9) thereby expanding the portion of each picket located inside of the rail partially radially outwardly within the rail in first and second diverging directions generally perpendicular to the first and second converging directions to thereby prevent further passage of the pickets through the respective entry apertures.

As to Claim 27. Lichti discloses the first and second diverging directions being perpendicular to a longitudinal axis of one of the plurality of pickets (Fig 9).

As to Claim 28. Lichti discloses wherein each picket passes through only one side of the rail and ends within the rail (Fig 8).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lichti in view of Bush (US Patent 2,590,929).

Lichti discloses the fence panel significantly as claimed but does not disclose the holding apertures being offset from the entry apertures so that the pickets are not perpendicular to the rail nor the internal wall being moveable within the rail to vary the alignment of the holding apertures and the entry apertures.

Bush teaches a similar fence assembly having entry apertures defined by movable internal wall portions (9) being offset so that the pickets are not perpendicular to the rail (Figs 5-6) and "for spacing the [pickets] and holding them against lateral movement, or in a direction lengthwise of the rails" (Col 2, Lines 38-40). It would have been obvious to one of ordinary skill in the art to modify the interior wall of Lichti to have



the additional internal wall as taught by Lichti for spacing the pickets and holding them against lateral movement, or in a direction lengthwise of the rails.

Claims 24 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lichti.

Lichti discloses the fence panel significantly as claimed but does not disclose each picket passing through entirely opposite sides of the rail and ends outside the rail. Examiner takes Official notice that it is well known within the fencing/railing art and it would have been obvious to one of ordinary skill to extend the end of a picket through a second side of the rail for many reasons such as to extend the height of a rail, to add extra security to the fence itself to prevent birds or other animals from perching on top of the railing, etc.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3, 6, 7, 9-13 and 24-29 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA T. KENNEDY whose telephone number is (571)272-8297. The examiner can normally be reached on M-F: 7am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua T. Kennedy/  
Examiner, Art Unit 3679  
5/1/2008

/Daniel P. Stodola/  
Supervisory Patent Examiner, Art Unit 3679